

REMARKS

Claims 1-14 were pending in this application.

Claims 1-14 have been rejected.

Claims 4, 10 and 12 have been amended.

Claim 15 has been added.

Claims 1-15 are now pending in this application.

Reconsideration and full allowance of Claims 1-15 are respectfully requested.

Claims 4, 10 and 12 have been amended to correct typographical errors.

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,628,891 B1 to Vantalon et al. ("*Vantalon*") in view of U.S. Patent Application Publication No. 2003/0103532 A1 to Bertram et al. ("*Bertram*") and U.S. Patent Application Publication No. 2002/0101991 A1 to Bacon et al. ("*Bacon*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re*

deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

For the reasons set forth below the Applicant respectfully submits that the Patent Office has not established a *prima facie* case of obviousness with respect to Claims 1-14 of the Applicant's invention.

Vantalon recites a set-top box and Conditional Access Module (CAM). (*Figure 4 and Col. 6, Lines 8-11*). The set top box includes in-band (IB) and out-of-band (OOB) receivers that receive signals from a communications network. (*Col. 6, Lines 13-21*). The outputs of the receivers are coupled to a transport stream co-processor in the CAM. (*Col. 6, Lines 22-23*). The CAM supplies digital video and digital audio to a decoder in the set top box via a transport stream and communicates out-of-band information to a microprocessor in the set top box via an extended channel. (*Col. 6, Lines 33-65*).

Regarding independent Claims 1, 4, 7 and 12, the Office Action acknowledges that *Vantalon* fails to disclose "a system or method where the CAM sends the OOB data as packets" as recited in Claim 1. (*Office Action, Page 2, Last paragraph*). The Office Action then asserts that *Bertram* discloses this element of Claim 1 and that it would be obvious to combine *Vantalon* with *Bertram*. (*Office Action, Page 3, First full paragraph*).

Bertram recites an interactive information distribution system containing a distribution network connecting service provider equipment to subscriber equipment. (*Figure 1 and paragraph [0018]*). Content data, which is relatively static, and asset data, which may change, are sent as interleaved, or multiplexed, packets from the service provider equipment through the distribution network to subscriber equipment via in-band channels. (*Paragraphs [0020] and [0034]*). Packets

of content data and asset data are stored separately and interleaved just before being sent, in order to avoid the need to re-multiplex the packets with each change in asset data. (*Paragraph [0008]*). Data such as commands and encryption keys are sent from a Session Controller through the distribution network to subscriber equipment via out-of-band channels. (*Paragraph [0032]*).

The Office Action fails to show that a person skilled in the art would combine the recitations of *Vantalon* with *Bertram*. First, the system of *Vantalon* provides content and data to separate destinations in the set top box via separate signal paths; i.e., two signals are sent from two sources via two signal paths to two destinations. Further, while *Bertram* teaches a system communicating both content and asset data packets to subscriber equipment over an in-band channel, it also teaches the continued employment of an out-of-band channel for communicating command and encryption data to that same subscriber equipment. As such, *Bertram* teaches a technique of communicating three signals from two sources via two signal paths to a single destination.

The Office Action explains that a person skilled in the art would combine the two references in order to send two signals from two sources via one signal path to two destinations “in order to provide a more organized means of sending data to the receiver so that the data can be easily updated if need be.” While the proposed motivation addresses the problem faced in *Bertram* of reducing the need for re-multiplexing static content data and varying asset data, the system of *Bertram* continues to use separate in-band and out-of-band communication channels. Further, there is no suggestion in *Vantalon* of a disadvantage that would be overcome by the use of the techniques of the Applicant’s

invention. Thus, there is neither suggestion nor motivation in *Vantalon* and *Bertram*, either alone or together, to combine the reference teachings.

The Applicant respectfully asserts that the Examiner has inappropriately applied hindsight when combining the teachings of the *Vantalon* reference and the *Bertram* reference in order to arrive at the claimed invention recited in independent Claim 1. The teaching of the use of transport stream packets to send out-of-band service information from a point of deployment module to a set top box comes from the Applicant's patent application. As such, a *prima facie* case of obviousness has not been established and the Applicant respectfully submits that the rejection of Claims 1-14 under 35 U.S.C. § 103(a) should be withdrawn.

Independent Claims 1, 4, 7 and 12 each recite a point of deployment module or data module that sends out-of-band service information to a set top box or host device, respectively, in transport stream packets using a transport stream channel. Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections and full allowance of independent Claims 1, 4, 7 and 12 (and their dependent claims).

II. NEW CLAIMS

The Applicant has added new Claim 15. The Applicant respectfully submits that no new matter has been added. The Applicant respectfully requests entry and full allowance of Claims 15.

III. CONCLUSION

For the reasons given above, the Applicant respectfully requests reconsideration and full allowance of all pending claims and that this application be passed to issue.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.


The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: _____

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